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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,329	03/01/2002	Takashi Nara	47793/57534	3044
21874 7590 04/06/2009 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
DAGNEW, SABA				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
04/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/087,329

**Applicant(s)**

NARA ET AL.

**Examiner**

SABA DAGNEW

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12, 13 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 13 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 31<sup>st</sup> and November 3, 2008 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12, 13 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Buhler et al (US Patent Number 6,077,193).

With respect to claims 12 and 17, Buhler teaches a point-giving server for giving a user points and a program embodied on computer-readable medium for performing a point-giving procedure which gives a point to user, the point-giving server comprising:

a data acquiring unit, said data acquiring unit operable to communicate with a fitness tool that allows a user to exercise, and acquire a character string or image (**Col. 2, lines 30-46**, where “data collector module” reads on a data acquiring unit, installed (communicates) on any exercise machine such as where “treadmill, bicycle, climber etc..” reads on fitness tool, and readout data)

wherein said fitness tool is selected from the group consisting of a pedometer, a stepper, a dumbbell, a rope for jumping rope, a popping, a twister, twister, an exercise bike, a walker and a party game requiring a player's movement (**Col. 2, lines 30-46**, which teaches exercise equipments, such as exercise treadmill, exercise bicycle and exercise star climber);

a converter operable to convert said character string or image acquired by said data acquiring unit to points, which are accumulating as mileage points of an airline or card points of a credit card company by using a point converting table which makes said character string or image correspond to said points, the accumulated points being in proportion to an amount of a service **used** (**Col. 2, lines 31-39**, which teaches collecting incentive point , where “incentive point” reads on mileage point, **Col. 4, lines 56- 67**, **and Col. 5, lines 1-5**, which teaches number of points accumulated based on the exercise program); and

an output unit operable to output said points generated by said converter to increase points accumulated for said user (**Col. 5, lines 9-17**, which teaches displaying information, prompts heart detection including awarding points).

With respect to claim 13 Buhler teaches all elements of claim 12, furthermore, Brown teaches a point-giving server wherein said data acquiring unit acquires a plurality of types of character strings or images (**Col. 4, lines 46-67**, which teaches "*The Data Collector Unit*" reads plurality of strings such as, fitness level and program name, number of points etc...). and

said converting table makes combination of said plurality of types of character string or image to a plurality of points, respectively and converts each of said combination of said plurality types of character strings or image to corresponding points (**Col. 4, lines 46-67**, which teaches "*The Data Collector Unit displays accumulated points based on the level and program name*").

#### ***Response to Arguments***

Applicant's arguments with respect to claim 12 and 17 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D./  
Examiner, Art Unit 3688

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688